

DT20 Rec'd PCT/PTO 27 JAN 2003

PATENT
Serial No. 08/983,394

PCT
#11

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT
APPLICATION OF:

Douglas S. FALLS, *et al.*

SERIAL NO.:

08/983,394

FILING DATE:

January 20, 1998

ART UNIT:

to be assigned

EXAMINER

to be assigned

FOR:

ELECTRONIC PRODUCT INFORMATION DISPLAY SYSTEM



29315

PATENT & TRADEMARK OFFICE

RENEWED PETITION UNDER 37 C.F.R. §1.137(b)

Attn: PCT Legal Office

Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

In response to the Decision on Petition Under 37 C.F.R. §1.137(b) ("Decision"), mailed November 27, 2002, Petitioner submits this Renewed Petition Under 37 C.F.R. §1.137(b).

It is believed that no fees are due in connection with the filing of this Renewed Petition. However, in the event that it is determined that fees are due, the Commissioner is hereby authorized to charge the undersigned's Deposit Account No. 50-0311 (Ref. No. 22249-502).

In response to the Decision, Petitioner submits the following remarks:

REMARKS

A grantable petition under 37 C.F.R. §1.137(b) requires:

- (1) the required reply, unless previously filed;
- (2) the petition fee required by law;
- (3) a statement that the “entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional;” and
- (4) any terminal disclaimer and fee required pursuant to 37 C.F.R. §1.137(c).

In the Decision, the PCT Petitions Attorney has acknowledged that item (2) is satisfied, and that item (4) is not required for this application. *See* Decision, pg.3.

The PCT Petitions Attorney also alleges that items (1) and (3) have not been satisfied. *See* Decision, pgs. 2-3. Although Petitioner disagrees with the findings regarding items (1) and (3), further clarification with regard to each of these items is provided below.

A. Item (1)

The PCT Petitions Attorney alleges that the declaration submitted with the August 5, 2002 petition as the “required reply,” is not acceptable for the following reason:

“The three page document consists of one copy of a page identified as “Page 1 of 2” and two different copies of pages identified as “Page 2 of 2.” The pages identified as “Page 2 of 2” are not identical. One version of page 2 identifies three of the four inventors, and is executed by these three; the second version of page 2 identifies only the fourth inventor, A. Scott McPhillips, and is executed by him. Because the pages are all identified as being part of a two page declaration, it is not clear whether the inventors were presented with the full three page document submitted here...or whether two separate two page declarations...have been compiled into a single document.” *See* Decision, pg. 2.

The declaration submitted included two separate pages marked “page 2 of 2,” as these appear to be pre-printed forms. Petitioner attaches herewith **EXHIBIT A**, which is a declaration

of Robert S. Beiser. Mr. Beiser was the attorney that caused a copy of the declaration to be sent to Intelledge Corporation for execution by the four inventors.

In the Declaration, Mr. Beiser acknowledges that he caused a copy of the "Combined Declaration for Patent Application and Power of Attorney" attached to his declaration as APPENDIX A, to be sent to Intelledge Corporation for execution by the four inventors.

Mr Beiser further acknowledges that two versions of "Page 2 of 2" were used to set forth the names and addresses of all four inventors, and that, to the best of his knowledge, the "Combined Declaration for Patent Application and Power of Attorney" as a whole (as it appears in APPENDIX A of his declaration) was sent to each of the four inventors for their review and signature.

Accordingly, Petitioner contends that item (1) is satisfied, and requests that the PCT Petitions Attorney accept the "Combined Declaration for Patent Application and Power of Attorney" as the "required reply."

B. Item (3)

With regard to item (3), the PCT Petitions Attorney recites:

"The abandonment...occurred at the time when Intelledge and its appointed agents (Charles A. Laff, et al.) were controlling the prosecution of the application. Further statements must be provided by persons who controlled this prosecution at the time of abandonment before a determination can be made as to whether a decision was made to intentionally abandon the application." *See* Decision, pg. 3.

In response, Petitioner attaches herewith **EXHIBIT B** and **EXHIBIT C** which correspond, respectively, to the involvement of James B. Sharwarko (of Intelledge Corporation),

and Charles A. Laff in the prosecution of the above-referenced application at the time of abandonment.

EXHIBIT B is a declaration of James B. Sharwarko. In the declaration, Mr. Sharwarko acknowledges that, as the Vice President of Finance and Chief Financial Officer of Intelledge, he had administrative responsibility for patent matters, and served as the contact at Intelledge for the law firm of Laff, Whitesel, Conte, and Saret, Ltd. for the above-referenced patent application.

In paragraphs 9-11 of the Declaration, Mr. Sharwarko acknowledges that:

“9. From September, 1998 through January, 1999, I was unaware that the above-referenced patent application was in jeopardy of becoming abandoned. Moreover, I did not receive any correspondence from the law firm of Laff, Whitesel, Conte & Saret, Ltd. notifying me that the above-referenced patent application was in jeopardy of becoming abandoned.

10. As Vice President of Finance and Chief Financial Officer, and the individual having administrative responsibility for patent matters for Intelledge, I did not intend for the above-referenced patent application to go abandoned.

11. For at least these reasons, Intelledge did not intentionally abandon the above-referenced patent Application.”

See **EXHIBIT B**, pgs. 2-3, ¶s. 9-11.

Mr. Sharwarko's acknowledgment that: (1) he was unaware that the patent application was in jeopardy of becoming abandoned; and (2) that he did not receive any correspondence from the law firm of Laff, Whitesel, Conte & Saret, Ltd. notifying him that the patent application was in jeopardy of becoming abandoned, is consistent with statements made by Charles A. Laff, as explained below with regard to **EXHIBIT C**.

EXHIBIT C is a letter from James G. Gatto (currently one of the Attorneys of Record in the above-referenced application) to Charles A. Laff, dated January 16, 2003. In this letter, Mr.

Gatto refers to a telephone conference that occurred on June 18, 2002, during which Mr. Laff indicated to Mr. Gatto that his file for Serial No. 08/983,394 contained neither: (1) a Notification of a Defective Oath or Declaration from the U.S. Patent Office, nor (2) any correspondence to Intelledge regarding such a Notification.

In the letter, Mr. Gatto recites:

“Please confirm that our understanding of these two points is correct, or, if you have any such correspondence, please send it to us by January 21, 2003. If we fail to receive any documents from you, we will assume our understanding is correct.”
See EXHIBIT C, pg. 1, ¶3.

Mr. Laff’s statement (during the June 18, 2002 telephone conference) acknowledging that his file had no record of correspondence to Intelledge informing them of a Notification of a Defective Oath or Declaration is consistent with Mr. Sharwarko’s acknowledgement that Intelledge was unaware of the Notification.

As of January 27, 2003, the filing date of this Renewed Petition, no correspondence or further communication has been received from Charles A. Laff with regard to this matter.

Accordingly, Petitioner contends that item (3) is satisfied, and requests that the PCT Petitions Attorney withdraw the previous finding to the contrary.

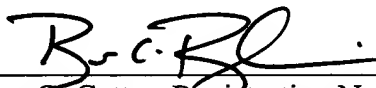
CONCLUSION

On the basis of the foregoing, the Petitioner respectfully requests the granting of this Renewed Petition so that the application will be taken up promptly, and respectfully solicit favorable examination at that time. Should the PCT Petitions Attorney believe that a telephone call would expedite resolution of this matter, or believe that any supplemental information would be helpful, a telephone call to the undersigned is encouraged.

Respectfully submitted,

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY, AND POPEO, PC

By:


James G. Gatto - Registration No. 32,694
Bradford C. Blaise - Registration No. 47,429

Date: **January 27, 2003**

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